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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,153

08/21/2003

Michael Delaney

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66880 7590 06/26/2008

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EXAMINER

THOMASSON, MEAGAN J

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

06/26/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/645,153	<b>Applicant(s)</b> DELANEY ET AL.	
	<b>Examiner</b> MEAGAN THOMASSON	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1-15 are pending in this application. No amendments have been made to the claims.

### ***Inventorship***

In view of the papers filed October 22, 2007, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of Robert A Luciano, Jr.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tulley et al. (US 7,179,168 B1).**

Regarding claims 1,6,11 Tulley discloses a system and method for allocating an outcome amount among a total number of events, wherein a central server generates a game result using a fixed-pool of elements, each element corresponding to a game play result (col. 7, lines 42-45), a player terminal in operable communication with said central server, configured to send game play requests to said central server and receive game play results from said central server (col. 8, lines 42-50), said player terminal further configured to determine a base game play results and a secondary game play result from a single game play result received from said central server, to reverse-map said base game play result into a display such that said display shows game indicia having a value corresponding to said base game play result, and further shows secondary game indicia different from said base game play display, having a value corresponding to said secondary game play result, wherein the single game play results is a fixed sum that is awarded to the player.

Specifically, Tulley discloses an embodiment of the invention in col. 10, lines 10-65 wherein a player purchases \$5.00 worth of events from a gaming service and the gaming service determines the player's total event outcome will total \$8.00, i.e. the player will win a total prize of \$8.00, to be awarded in a series of events. The player chooses to play a base slot-machine type game, wherein a portion of the total event outcome is awarded to the player. The player then chooses to play a secondary game having different indicia from the base game, and the remainder of the total event outcome is then awarded to the player. The manner in which the game outcomes are

displayed to the player are determined by the total outcome amount, i.e. the total outcome amount is reverse-mapped into a series of displays.

*Tulley does not specifically disclose the player terminal is configured to determine a base game play result and a bonus game play result from a single game play result.* Instead, Tulley discloses that a player may choose to play multiple games, including base games and secondary games, in order to display and obtain the total winning amount generated by the central server. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the event outcome allocation technique of Tulley to a slot machine having a base game and a bonus game as to do so would have yielded predictable results. In this case, the technique for improving a particular class of devices, i.e. slot machines having means to allocate awards, was part of the ordinary capabilities of a person of ordinary skill in the art as both inventions result in the player having earned \$8.00 as their total event outcome.

Regarding claims 2,3,7,8,12 and 13, Tulley discloses a secondary game indicia comprises a plurality of indicium wherein said plurality of indicium is selectable and where said result is divided into a set of partial win results that, in total, are an amount equal to said results, and wherein said partial win results are awarded one at a time as a result of selectable indicium being selected until all of said partial win results are awarded (col. 10, lines 42-55), as the player selects a plurality of boxes each box containing a portion of the total win outcome.

Regarding claims 4,9,14 Tulley discloses the use of an indicator recognizable by said player terminal to indicate a game play result (col. 10, lines 20-24).

Regarding claims 5,10,15 Tulley discloses the secondary game play amount is calculated by subtracting a known base game amount from said game play result (col. 10, lines 47-55), wherein the amount won by the player in the base game is subtracted from the total winning amount to obtain the amount to be won in the secondary game.

### ***Response to Arguments***

Applicant's arguments, see Remarks P. 5, filed January 16, 2008, with respect to the 35 U.S.C. 102(e) rejection of claims 1-15 have been fully considered and are persuasive. The 35 U.S.C. 102(e) rejection of claims 1-15 has been withdrawn.

Applicant's arguments filed January 16, 2008 with respect to the 35 U.S.C. 103(a) rejection of claims 1-15 as being unpatentable over Tulley et al. have been fully considered but they are not persuasive. Specifically, applicant argues that the claim element of "a player terminal configured to determine a base game play result and a bonus game play result" is not taught or suggested by Tulley (Remarks, P. 5-6), and instead the multiple games taught by Tulley suggest only a plurality of base games that a player may choose to try. The examiner respectfully disagrees with this narrow definition of the term "bonus game", as the multiple games taught by Tulley are in addition to a primary or basic slot machine game. For instance, an example given by Tulley allows a player to play a simulated slot machine game and an additional treasure maze type of game (col. 10, lines 24-56). This treasure maze game is, in the broadest reasonable interpretation of the term, a bonus game in that it is in supplemental to a basic slot machine type game. Any game that is in addition to the original game

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selection may be considered a “bonus” game in that it is an extra feature for player entertainment purposes.

Additionally, even if this definition of “bonus game” is not the definition intended by the applicant, the examiner maintains the rationale stated in the previous office action. Specifically, applying the event outcome allocation technique to a slot machine game having a base game and a bonus game that is based upon or triggered by an outcome obtained in the base game would have yielded predictable results. Further evidence of the predictable results obtained from such a combination can be seen in Nicastro, SR. (US 2003/0027619 A1), ¶0085 (emphasis added), stating that:

Those skilled in the art will appreciate that many variations on the basic game and bonus game describe herein are possible in keeping with the spirit and scope of the present invention. The particular graphical elements can be arranged differently or have a different appearance. The overall game theme can be a different, such as hound and hare rather than cat and mouse. **The basic game can be any video game offering a winning combination that earns a bonus game entry combination, such as a video slot machine game**, video poker, video blackjack, video keno, or the like. The bonus game can be any video game offering the player increased participation and logic based decision making, such as tile games, predator-prey games, games that require matching like objects, trail games requiring directional decisions to reach a target area, word puzzle or trivia type games, **mazes**, or any game that allows or requires a decision due to a plurality of multiple possible outcomes, especially when the player is provided with a status area showing possible outcomes or choices, or the like. **The bonus game can also be any game or video game offering the player increased participation and requiring physical skill**, such as driving or race games; basketball, handball, and toss games; golf, tennis, baseball, racquetball, ping pong games; and target shooting, marksmanship, first person shooter games, Space Invader-like video

games, and carnival-type shooting games. Bonus games requiring physical skills may also require mental dexterity. Combinations of the example games can also be used.

The examiner maintains the rejection under 35 U.S.C. 103(a), that the claimed invention is not new, novel or unobvious over that disclosed by Tulley et al.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent prior art includes Nicastro, SR. (US 2003/0027619 A1), used as evidence of obviousness of the predictable results obtained by including the base game and intended definition of bonus game in the invention disclosed by Tulley et al.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEAGAN THOMASSON whose telephone number is (571)272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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